

Appl. No. 10/694,978
Amdt. dated August 1, 2006

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REMARKS

Claims 1–34 are cancelled. New claims 35–53 are pending.

Claims 35-38, 49-50 and 53 have been amended to recite an antibody that specifically binds to a polypeptide “consisting of”, rather than “having”, the amino acid sequence of SEQ ID NO.: 2.

Claims 47-48 and 51-52 have been amended to recite an antibody that specifically binds to a polypeptide “comprising”, rather than “having”, the amino acid sequence of SEQ ID NO.: 2.

Applicant believes that no new matter is added by way of amendment.

I. Amendments to the Claims.

The present claims have been further amended relative to the June 2 claims as follows: claims 35-38, 49-50 and 53 have been amended to replace “having” with “consisting of,” as suggested in the Advisory Action; claims 47-48 and 51-52 have been amended to replace “having” with “comprising.” The amendment to claims 47-48 and 51-52 is intended solely to clarify the intended claim scope.

II. Rejections under 35 U.S.C. §§102(e) and 103(a).

Claims 35-38, 49-50 and 53 have been amended as suggested in the Advisory Action, and are now believed to be free of the prior art (e.g. U.S. Pat. No. 5,011,912).

Claims 47-48 and 51-52 have been amended to maintain open “comprising” transitional language. The reason for amending claims 35-38 (and claim 53) to the closed transition “consisting of” was to avoid encompassing within the scope of the claims prior art binding compounds that bind to, e.g., FLAG domains, if such FLAG domains were to occur within fusion-proteins comprising SEQ ID NO: 2. See Advisory Action at Continuation Sheet, citing U.S. Pat. No. 5,011,912. Although Applicant believes that the June 2 claims were adequately limited to exclude such embodiments through use of the phrase “specifically binds,” Applicant nonetheless amends claims 35-38 and 53 as requested in order to speed prosecution. Method claims 49-50 are also amended as suggested in order to speed prosecution.

Claims 47-49 and 51-52, however, have not been amended to recite “consisting of” because that limitation is not required to avoid prior art for these claims. Claims 47-

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49 and 51-52 are kit and method claims including as an element the binding compounds (compositions of matter) of claims 35 or 37. In Claims 47-49 and 51-52, unlike claims 35-38 and 53, the "polypeptide" limitation does not help define the specificity of a binding compound, and thus these claims do not need to include the closed "consisting of" transition to avoid reading on prior art binding compounds.

Put another way, if claims 35 and 37 are free of the prior art, then claims incorporating all the limitations of those claims should also be free of the prior art.

The Advisory Action further argues that claim 35 would be rejected under 35 U.S.C. §102(e) because the sequence "ILLGV" (amino acids 109-113 of SEQ ID NO:2) is present in SEQ ID NO:2 of the TANGO-77 protein of U.S. Patent No. 6,117,654. However, claim 35 recites the sequence "SLILLGV" (amino acids 107-113 of SEQ ID NO:2), which is two amino acid residues longer than the sequence listed in the rejection, and which sequence is not found in the TANGO-77 protein. For this reason Applicant believes that claim 35 is not anticipated by U.S. Patent No. 6,117,654.

In light of the amendments to the claims and arguments provided herein and in the after-final response dated June 2, 2006, Applicant respectfully requests that the rejections under 35 U.S.C. §§102(e) and 103(a) be withdrawn.

Conclusion

Applicant's current response is believed to be a complete reply to all the outstanding issues of the latest Office action. Further, the present response is a bona fide effort to place the application in condition for allowance or in better form for appeal. Accordingly, Applicant respectfully requests reconsideration and passage of the amended claims to allowance at the earliest possible convenience.

Applicant believes that no additional fees are due with this communication. Should this not be the case, the Commissioner is hereby authorized to debit any charges or refund any overpayments to DNAX Deposit Account No. 04-1239.

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If the Examiner believes that a telephonic conference would aid the prosecution of this case in any way, please call the undersigned.

Respectfully submitted,

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